

Upon review of the Examiner's Answer, Appellant wishes to address the Examiner's Remarks (Examiner's Answer, page 23). Specifically, herein addressed are the rejections of the new limitations of "only one" and "batch", added with the submission of RCE on October 22, 2010 and amendment of March 23, 2010, respectively.

II. REJECTION under 35 U.S.C. § 103

Stenman in view of Shim fails to teach or suggest all of the limitations of Claims 16, 19, 22, 26, 29, 32, and 36-38

Neither Stenman nor Shim teach "a group of remote control codes for only one predetermined controlling operation" and "transmission means for transmitting to the target equipment the group of remote control codes as a batch for the only one predetermined controlling operation to be performed on the target equipment in response to a user operation" as recited in the claims of the present invention.

Appellant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claims 16, 19, 22, 26, 29, 32 and 36-38 pursuant to 35 U.S.C. § 103(a). To establish a *prima facie* case of obviousness under § 103, the Examiner must show that the prior art references teach or suggest all of the claim limitations, there must be a reasonable expectation of success of the combination and there must be a motivation to combine the references. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Pro arguendo, even if there is a motivation to combine Stenman and Shim, the hypothetical combination fails to teach or suggest the above-identified limitations for at least the following reasons.

The Examiner asserts that the “one predetermined controlling operation” limitation is not narrowed to exclude reasonably broad interpretation that can constitute both a single or multiple instructions to be transmitted to a targeted piece of equipment as a user’s selected ‘operation’” (Office Action mailed June 22, 2010, page 2 and Advisory Action mailed December 29, page 2).

However, the independent claims recite “only one predetermined controlling operation”, not “one predetermined controlling operation” as the Examiner contends. It has been held by the courts that “All words in a claim must be considered in judging the patentability of that claim against the prior art.” (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), M.P.E.P.2143.03 and M.P.E.P.2106II, C). Thus the Examiner’s interpretation of “one predetermined controlling operation” is inapposite because this interpretation does not consider the word “only” when judging the patentability of the claim against the prior art.

Appellant points out that “only one” is different from “one.” While it is reasonable to interpret that “multiple” does not include “one”, even if “multiple” could read on “one” as the Examiner asserts and Appellant disputes, it cannot be said that “multiple” reads on “only one” because “only one” is always one, whereas “multiple” is a number greater than one. That is, “happens to be more than one” and “always one” are different, so that “multiple” does not teach or suggest “only one.”

Moreover, the Examiner’s broad interpretation of the phrase “only one predetermined controlling operation” as being disclosed by multiple operations including one operation is not reasonable. The courts have held that “The broadest-construction rubric ... does not give the PTO an unfettered license to interpret claims to embrace anything

remotely related to the claimed invention.” *In re Suitco Surface Inc.*, 603 F3d 1255, 94 USPQ2d 1640, 1644 (Fed. Cir. 2010). A reasonable interpretation of appellant’s claims does not include interpreting “multiple” as “only one” because this interpretation does not examine the plain language of the claims to determine their meaning.

Therefore, Shim does not teach “a group of remote control codes for only one predetermined controlling operation” as recited in the independent claims of the present invention.

Also, the Examiner asserts that Stenman teaches “storage means for storing a group of remote control codes for only one predetermined controlling operation to be performed on the target equipment; and transmission means for transmitting to the target equipment the group of remote control codes for the only one predetermined controlling operation to be performed on the target equipment in response to a user operation” at column 3, lines 30-33 and column 7, lines 49-65 (Office Action mailed June 22, 2010, page 4). Stenman teaches a user interface 2050 and command control module 2025, wherein a user can control the various peripheral devices through spoken commands. Control of the peripheral devices 2040 is effectuated via a dual tone multifrequency (DTMF) recognition module 2060 responsive to DTMF commands keyed in by a user. Additional command formats may also be used to control the peripheral device through some type of command module. Alternatively, the user interface 2050 may include means for initiating commands through the use of buttons, a touch screen, joystick or other type of mechanical controller useful for handicap individuals. Accordingly, Stenman teaches controlling various devices with various commands. Stenman cannot be said to teach a group of remote control codes for

only one predetermined controlling operation as recited in the claims of the present invention.

In addition, the claims recite “transmission means for transmitting to the target equipment the group of remote control codes as a batch for the only one predetermined controlling operation to be performed on the target equipment in response to a user operation,” (emphasis added), which is not taught by Stenman. Accordingly, Stenman does not cure the deficiency of Shim.

Therefore the hypothetical combination of Shim and Stenman does not teach or suggest each feature of independent claims 16, 19, 22, 26, 29, 32 and 36-38. Thus, appellant submits that the rejection under 35 U.S.C. § 103 is in error and must be reversed.

III. Conclusion

It is clear that all of the limitations recited in claims 16, 19, 22, 26, 29, 32, and 36-38 are not obvious in light of the hypothetical combination of Stenman in view of Shim. Consequently, Appellant respectfully submits that the rejections of the claims based on this combination of references is in error.

In view of the remarks and arguments set forth in this Reply Brief, Appellant respectfully requests that the rejections under 35 U.S.C. § 103(a) citing the aforementioned references made in the Final Rejection dated June 22, 2010 be reversed by the Board of Patent Appeals and Interferences.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection herewith to Deposit Account No. 19-1013/SSMP.

Respectfully submitted,

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